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30 JAN 2006

Smith Gambrell & Russell
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In re Application of
RUSSELL et al.
Application No.: 10/522,809 : DECISION
PCT No.: PCT/AU03/00393 :
Int. Filing Date: 31 March 2003 :
Priority Date: 31 July 2002 :
Attorney Docket No.: 034164.002 :
For: ANIMATED MESSAGING :
:

This is a decision on applicants' submissions filed 10 November 2005 and 23 November 2005 in the United States Patent and Trademark Office (USPTO), which together have properly been treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 31 March 2003, applicants filed international application PCT/AU03/00393, which designated the United States and claimed a priority date of 31 July 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 05 February 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 31 January 2005.

On 31 January 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and an assertion of small entity status.

On 09 June 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 10 November 2005, applicants filed a submission which included, *inter alia*, a petition/fee for a four month extension of time, a declaration of inventors, and the surcharge under 37 CFR 1.492(e) for providing the declaration of inventors later than thirty months from the priority date.

On 23 November 2005, applicants filed a "DECLARATION OF NICHOLAS RUSSELL IN SUPPORT OF ONE CO-INVENTOR SIGNING ON BEHALF OF ANOTHER".

DISCUSSION

As noted above, the submission filed 10 November 2005 and 23 November 2005 together have been properly treated as a petition under 37 CFR 1.47(a).

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee of \$200 has been charged to Deposited Account 02-4300. Accordingly, item (1) has been met.

Item (4) has been met as well.

As to item (3), a clear statement of the last known address of the missing inventor has not been given. Thus, item (3) has not been met.

Item (2) has not been met. As noted in MPEP § 409.03(d), the statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Here, it is not clear that Nicholas Russell has firsthand knowledge of the facts recited in the declaration by him. Statements based on hearsay will not normally be accepted. Additionally, to establish a refusal to sign, it is required that the inventor be presented with the application papers (specification, including claims, drawings, and oath or declaration). See MPEP 409.03(d). "It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)." MPEP 409.03(d). Here, it is not clear that Mr. Felich was presented with a copy of the application papers.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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